

Patent
Prior Attorney Docket No. 266/247
Current Attorney Docket No.: 949797-100014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

Inventor: Goldsmith, Edward M., et al.

Serial No.: 09/929,299

Filed: 8/14/2001

For: Hockey Stick

)
) **Group Art Unit: 3711**

)
) **Examiner: Graham, Mark S.**

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Commissioner for Patents

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**TRANSMITTAL OF BRIEF IN REPLY TO EXAMINER'S ANSWER
&
REQUEST FOR ORAL HEARING**

1. Enclosed herewith is the original and two copies of Brief in Reply to Examiner's Answer dated February 10, 2004 for the above-identified application.

2. Pursuant to 37 C.F.R. §1.194 Applicants hereby request an oral hearing. Enclosed herewith is completed form PTO/SB/32 Request for Oral Hearing Before the Board of Appeals and Patent Interferences. The Commissioner is hereby authorized to charge the fee pursuant to 37 C.F.R. 1.17(d) for the oral hearing or any other fees associated with this communication and the Applicants' Brief in Reply to Counsel's Deposit Account No. 50-2468.

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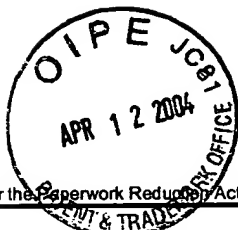
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REQUEST FOR ORAL HEARING BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) 949797-100014	
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		Application Number 09/929,299	Filed 8/14/2001
		For Hockey Stick	
		Art Unit 3711	Examiner Graham, Mark S.
Applicant hereby requests an oral hearing before the Board of Patent Appeals and Interferences in the appeal of the above-identified application.			
The fee for this Request for Oral Hearing is (37 CFR 1.17(d))		\$ 290.00	
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<input type="checkbox"/> applicant/inventor.		<u>[Signature]</u> Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		<u>Karun D. Naga</u> Typed or printed name	
<input type="checkbox"/> attorney or agent of record. Registration number _____		<u>213-489-3939</u> Telephone number	
<input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a) <u>52,057</u>		<u>April 12, 2004</u> Date	
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This collection of information is required by 37 CFR 1.194(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Sir:

This brief is in reply to the Examiner's Answer dated February 10, 2004 for which a reply is required to be filed within two months. 37 C.F.R. §1.193. Because April 10, 2004 falls on a Saturday, the date for submitting a timely Reply Brief is understood to extend to the next succeeding Business Day, which is Monday April 12, 2004, the date that this reply is being filed. 37 C.F.R.

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Karun Naga
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§1.7. A Request for Oral Hearing is being concurrently filed herewith. Claims 1, 2, and 17-30 are pending in the present application and are all on appeal. The "Real Party in Interest," remains Jas D. Easton, Inc., the assignee of the present application as set forth in the assignment recorded at Reel 010779, Frame 0410. With respect to the grouping of the claims, Applicants understand that the Examiner has accepted the groupings as set forth in Applicants' Appeal Brief (i.e., five groups of claims with respect to the 35 U.S.C. § 103(a) rejections). Applicants acknowledge the Examiner's withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1 and 2.

I. Claims 17-21 and 23-30 Are Not Obvious -- Malmberg Does Not Teach an *Outer Most Exterior Concave Surface As Defined by Claims 17-21 and 23-30*; Nor Does Malmberg Disclose or Otherwise Teach a *Reduced Width Dimension Relative to the Bordering Regions Located on Either Side As Defined by Claims 23-30*.

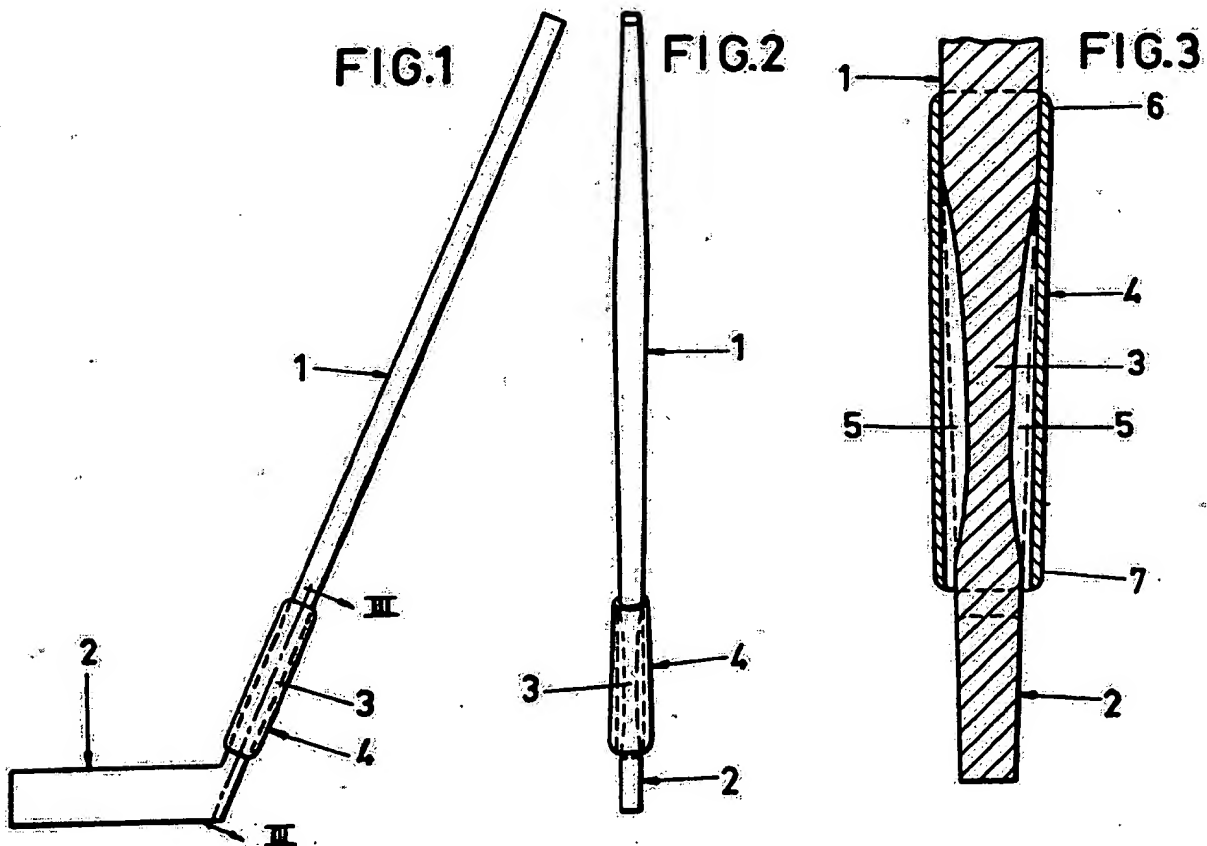
The Examiner's Answer contends that Malmberg discloses an (1) upper portion of a blade having an outer most exterior concave surface as defined by claims 17-21 and 23-30 and (2) that the outer most exterior concave surface includes a reduced width dimension, as measured between the outer most exterior surfaces, relative to the bordering regions located on either side of the concave surface. Because, the Examiner's Answer improperly characterizes the teachings of Malmberg in each of these regards, as discussed in Applicants' Appeal Brief and below, it is respectfully submitted that claims 17-21 and 23-30 are allowable.

There is no dispute that Malmberg discloses a hockey stick consisting of a shaft 1, a blade 2, a weakly dimensioned part 3 located on the lower portion of the shaft and a reinforcement device 4, which encases the shaft 1 and provides stiffness to the weakly dimensioned part 3. There is also no dispute that Malmberg does not disclose the weakly dimensioned part 3 absent the reinforcement device 4. This is clear not only from the drawings but also from the fact that the disclosure in

Malmberg specifically states that the reinforcement device 4 is slipped over the shaft around the weakened portion of the shaft *prior* to the blade being attached to the shaft.

According to the embodiment shown in the drawing, the reinforcement device 4 consists of a case or the like attached on the shaft 1 over the relatively weakly dimensioned part 3, which case is, at its first end 6 firmly attached to the shaft 1 and which, at its other end 7, is located some distance from the shaft 1. The case 4 is arranged such that it is slipped over the shaft 1 before the blade 2 is glued or otherwise attached to the shaft 1. (Malmberg translation at p. 2, ¶ 7).

Malmberg Figures 1-3



Notwithstanding, the Examiner's Answer takes the position that the reinforcement device 4 disclosed in Malmberg "is irrelevant to the structure which is actually being claimed" and concludes

that Malmberg clearly shows a blade with an upper portion having a concave "outermost portion."

(Answer at p.4).

However, the position taken in the Examiner's Answer is contrary to the law. In properly evaluating the prior art, examiners are "required to consider references in their entireties, i.e., including those portions that would argue against obviousness." *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1094 (Fed. Cir. 1985). Otherwise, "[t]he result is that the claims [will be] used as a frame, and individual naked parts of separate prior art references [will be] employed as a mosaic to recreate a facsimile of the claimed invention." *Id.* (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983)).

By impermissibly disregarding the reinforcement device 4 of the hockey stick disclosed in Malmberg, the Examiner's Answer incorrectly characterizes the weakly dimensioned part 3 of the hockey stick disclosed in Malmberg (an internal structure) as the outer most portion of the hockey stick even though there is no such teaching set forth in Malmberg. (Answer at p. 4). Claims 17-21 and 23-30 are each directed to either a detachable blade or a hockey stick. (comprising a shaft and a detachable blade) wherein the blade comprises an upper portion that further comprises an outer most exterior concave surface having a continuous curved transition into at least one of outer most exterior surfaces of the upper portion of the blade. As set forth above, Malmberg discloses neither a blade nor a hockey stick absent the reinforcement device 4. Furthermore, it is clear that the reinforcement device 4 defines the outer most exterior surface of the hockey stick disclosed in Malmberg. Moreover, it is also clear that the reinforcement device 4 is not concave. Consequently, because Malmberg neither teaches nor otherwise discloses "an outer most exterior concave surface"

as required and defined in claims 17-21 and 23-30, it is respectfully submitted that claims 17-21 and 23-30 are allowable.

Moreover, claims 23-30 each require "an outer most exterior concave surface" which "forms a region of reduced width dimension...relative to bordering regions on either side of the concave surface." As stated above, Malmberg neither teaches nor discloses "an outermost exterior concave surface." Therefore, there can be no teaching or suggestion in Malmberg of "an outer most exterior concave surface" having "a region of reduced width dimension" as required by claims 23-30. Accordingly, it is respectfully submitted that claims 23-30 are allowable on this additional basis.

II. Claims 1, 2, 17-21 and 23-29 Are Not Obvious Over Malmberg In View of Meumann (or *Vice Versa*) Because Those References Do Not Teach a Detachable Blade That Meets the Limitations of Those Claims

The Examiner's Answer restates the prior contentions that Claims 1, 2, 17-21, and 23-29 are unpatentable over Malmberg in view of Meumann or *vice versa*. (Answer at p. 3).

As set forth in Applicants' Appeal Brief and in Section I above, Malmberg simply does not disclose key limitations in claims 17-21 and 23-29 relied on by the Examiner's Answer to support or otherwise maintain the prior outstanding rejections of those claims. Consequently, Malmberg in combination with Meumann, or *vice versa*, cannot render claims 17-21- and 23-29 obvious under 35 U.S.C. § 103(a) because these references do not, as discussed above, teach or suggest *all* the claim limitations.

Applicants further argued in their Appeal Brief that it would be counterintuitive to combine the detachable blade disclosed in Meumann with the weakly dimensioned part 3 of the hockey stick disclosed in Malmberg. The Examiner's Answer attempts to dismiss the merits of Applicants' argument by stating that:

in the Malmberg in view of Meumann rejection it is Malmberg which is being modified. Malmberg already teaches the weakened area so it would not be contrary to weaken the hockey stick in this area. Meumann, the supporting reference merely teaches the well known replaceable blade concept for the purpose of replacing broken parts. Obviously if one applies this teaching to Malmberg, Malmberg's weakened area just above the shaft/blade transition falls in the upper portion of the blade piece of such a hockey stick as can be seen by Figs. 1 of Meumann and Malmberg respectively. (Answer at p. 5).

However, the Examiner's Answer fails to consider the teachings of the cited references in their entirety. Not only does the Examiner's Answer impermissibly disregard the external configuration of the hockey stick disclosed in Malmberg, the Examiner's Answer goes a step further by attempting to combine the disclosures Malmberg and Meumann in a manner that the cited references expressly teach away from doing. Specifically, the Examiner's Answer contends or otherwise suggests that one of ordinary skill in the art would combine Malmberg and Meumann to make a two piece hockey stick, wherein the detachable blade -- rather than the shaft -- would be weakened in the manner disclosed in Malmberg. (Answer at pp. 4-7). Because neither Malmberg nor Meumann disclose or even suggest such a combination and in fact when carefully considered teach away from such a combination, it is respectfully submitted that claims 1, 2, 17-21, 23-29 are allowable.

A. Neither Malmberg nor Meumann independently or in combination disclose or otherwise suggest a detachable blade having the weakly dimensioned part 3 disclosed in Malmberg.

Claims 1, 2 and 17-21 each have limitations directed to a *detachable* blade comprising an "upper portion" having a region of reduced longitudinal bending stiffness. Similarly, claims 23-29 are directed to a *detachable* blade comprising an upper portion having a region of reduced width dimension relative to the bordering regions on either side. Notably, Applicants do not claim any

such "weakened" region resides within or on the hockey stick shaft, but rather the claims require such regions only on the upper portion of the detachable blade.

In contrast, there is not dispute that Malmberg discloses a weakly dimensioned part 3 that is "part of the shaft 1" (Malmberg translation at p. 2, ¶ 2, See Fig. 3); while Meumann, on the other hand, discloses a means to detachably connect a wooden shaft to a wooden blade, so that the shaft may be reused with new blades thereby extending the life of the hockey stick. Notwithstanding, the Examiner's Answer contends that it is obvious that the combination of Malmberg and Meumann disclose a weakened portion on the upper portion of the detachable blade disclosed in Meumann because:

"[o]ne of ordinary skill in the art seeing the advantage of such a weakened portion (to get the spring action desired by Malmberg) in Meumann's stick would only logically look to the area taught by Malmberg as the proper area to weaken." (Answer at p. 5).

However, as previously noted there is no suggestion to combine Malmberg and Meumann in the manner suggested in the Examiner's Answer set forth above. Malmberg on the one hand discloses expressly discloses that the shaft not the blade include the weakened part 3, while Meumann on the other hand does not disclose or otherwise suggest that any area of the hockey stick be weakened. The attempt in the Examiner's Answer to sever the location of the weakened portion 3 disclosed in Malmberg from its underlying structure (i.e. the shaft) is simply not disclosed or otherwise suggest in either of the two references and as discussed in more detail below is in fact contrary to a fair reading of those references.

B. Weakening the detachable blade of Meumann would be contrary to the teachings in Meumann.

Malmberg, as previously noted, discloses a weakened portion on the shaft (not the blade) to obtain "a shock absorbing spring action" and avoid breakage between the blade and the shaft:

The present invention concerns a hockey stick or similar item consisting of a shaft, which in its lower end passes into a blade or the like, at which transition to the blade the shaft is relatively weakly dimensioned in order to allow some degree of shock-absorbing spring action when the stick is used. The aforementioned weak dimensioning of the shaft has the disadvantage that the club shafts often break. Through the present invention the aforementioned disadvantage is eliminated, and the hockey stick is characterized according to the invention by having a reinforcement device, which is intended to stiffen the shaft when the aforementioned part of the shaft has been deflected a small amount for the purpose of shock-absorbing spring action.

(Malmberg translation at p. 1). Thus, Malmberg expressly acknowledges that the transition between the shaft and the blade is not durable and therefore a reinforcement device is necessary to strengthen or stiffen the transition to make it more durable. Although, Malmberg discusses the lack of durability in the shaft-blade transition with respect to a one piece hockey stick (i.e. a hockey stick that does not have a detachable blade), Malmberg nevertheless acknowledges the inherent structural weakness in that area is susceptible to breakage and attempts to solve the problem by reinforcing the area on the one hand while weakening the area to some degree on the other to allow for spring action. In other words, Malmberg discloses a means for a shaft construction, which continually decreases in dimension as it transitions into the blade, so as to maintain the spring action that was derived from customary continuously reduced shaft dimension configurations while limiting or stiffening (i.e. strengthening) that shaft region to avoid breakage. Thus, Malmberg not only expressly discloses the weakening of the shaft (as opposed to the blade) but also clearly does so in the context of facilitating the weakening of the shaft while maintaining the spring action that is

traditionally or customarily obtained from a one-piece wood constructed hockey stick having a continuously or constantly decreasing width dimension.

The shaft 1 thus becomes relatively weakly dimensioned in the vicinity of the transition to the blade 2, and this is true even if the width decreases constantly as is customary with conventional hockey sticks. The aforementioned weakly dimensioned part of the shaft 1 is identified by the reference character 3.

The present invention provides the weakly dimensioned part 3, which is intended to allow some shock-absorbing spring action for the shaft 1, when the stick is used, with a reinforcement device 4, which is arranged such that it stiffens the shaft 1 when the part 3 has been deflected a small amount for the purpose of shock-absorbing spring action. Within certain limits, it is thus true that the shaft 1 maintains its entire shock-absorbing spring action.

(Malmberg translation at p. 2). Therefore, there can be no dispute that Malmberg is directed to a means (i.e. combining internal weakness coupled with additional external strength) for offsetting the inherent lack of durability in a shaft due the customary reduction in shaft dimension and does so in an attempt to maintain the customary shaft spring action derived from the continuous/constant reduction in shaft dimension and not to "focus" the flex point in the upper portion of the blade.

Similarly, Meumann specifically teaches that the blade portion of the hockey stick lacks durability and discloses a means by which a hockey stick shaft may be reused despite the lack of durability of the blade.

During the course of a game, a hockey stick can impact the playing surface hundreds of times, often at force levels equal to the maximum level for which the stick was designed. Hence, it is not uncommon for experienced players to break one or more sticks during each game. In many cases, a hockey stick breaks **at the hozel portion of the blade (the lower shaft portion immediately above the blade), thus leaving the majority of the shaft undamaged.** Disadvantageously, once a stick is broken, the hockey player must discard the entire hockey stick (shaft and blade), even though the shaft is otherwise in perfect condition. Additionally, the games inherently physical nature often results in chipping and splintering of the hockey stick blade. Even though technically usable, a splintered blade is not effective and is

usually discarded as well...**It is therefore an object of the present invention to enhance the useful life of wooden hockey stick shafts by eliminating the need to discard entire wooden hockey sticks that have broken blades.** It is another object of the present invention to **improve upon the design of a replacement blade that is usable with a wooden hockey stick shaft to enhance the performance and durability of hockey sticks as a whole.** (Meumann at Col. 1:19-34 and 2:22-29) (emphasis added).

Thus, Meumann expressly acknowledges that the upper portion (hozel portion) of the blade is the area of the hockey stick that is most susceptible to breakage. In addition, Meumann also discloses a design which "improves durability [of the blade] by using a hockey stick blade made of aluminum that will not easily splinter, break, or wear." (Meumann at Col. 2:45-47).

Thus, it would clearly be contrary to the teachings of Malmberg and Meumann to further weaken the upper portion, as suggested by the Examiner's Answer, of the blade that both Malmberg and Meumann clearly teach is the area most susceptible to breakage. Consequently, there can be no doubt that those references in fact *teach away* from the combination suggested in the Examiner's Answer. In fact, the suggested combination would exacerbate the problem addressed, although by different means, by both Malmberg and Meumann. To the extent that the Examiner's Answer therefore attempts to sever or otherwise relocate the structural location of the "weakened region" from the shaft to the blade, such a contention is simply not supported by the cited references and in fact are contrary to the express teachings in those references.

Accordingly, it is respectfully submitted that claims 1, 2, 17-21 and 23-29 are allowable over Malmberg in view of Meumann, or *vice versa*.¹

¹ It is noted that the Examiner's Answer distinguishes between the "Malmberg in view of Meumann" rejection and the "Meumann in view of Malmberg" rejection. However, both rejections are premised on an incorrect analysis of Malmberg's and Meumann's respective teachings and therefore both fail for the same reasons as set forth above.

III. Claims 22 and 30 Are Not Obvious Over Malmberg In View of Christian (or *Vice Versa*) Because Those References Do Not Teach a Detachable Blade That Meets the Limitations of Those Claims.

The Examiner's Answer contends that Claims 22 and 30 are unpatentable over Malmberg in view of Christian, or *vice versa*. (Answer at p. 3). Notably, it appears that the Examiner's Answer in this regard employs Christian as opposed to Meumann because Christian discloses a fiber reinforced detachable blade where as Meumann does not.

As set forth in Applicants' Appeal Brief and in Section I above, Malmberg simply does not disclose key limitations in claim 30 relied on by the Examiner's Answer to support or otherwise maintain the prior outstanding obviousness rejection of that claim. Consequently, Malmberg in combination with Christian, or *vice versa*, cannot render claim 30 obvious under 35 U.S.C. § 103(a) because these references do not, as discussed above, teach or suggest *all* the claim limitations.

As previously discussed in Section I and II above, Malmberg does not disclose or otherwise suggest that the *blade* be weakened as suggested by the Examiner's Answer but rather clearly contemplates a means for strengthening a customary single-piece hockey stick shaft that is already inherently weakened by its constant (continuous) reduction of width as it mates with the blade. In fact, as discussed above, the very premise of Malmberg is an acknowledgement that the transition between the shaft and blade of a customary hockey stick is an area of inherent structural weakness and therefore requires reinforcement for which Malmberg discloses a means for doing so.

Applicants Appeal Brief argued that it would be counterintuitive to combine the detachable feature employed in Christian with the (internal) weakened part 3 disclosed in Malmberg because the combination suggested in the rejections stands in direct conflict with the teachings of Malmberg and Christian. In this regard, the Examiner's Answer contends:

it would be completely intuitive to one of ordinary skill in the art to provide the teachings of Malmberg to Christian to obtain a springy area of the stick, while still maintaining the strength needed to prevent the stick from easily breaking. In a similar vein one of ordinary skill in the art seeking to provide a detachable blade portion for Malmberg's stick which includes a reduced thickness bendable portion would obviously have recognized the value of the teachings of Christian as to the use of fiber reinforcement to help ensure that such a detachable blade portion would be of sufficient strength which is completely desirable in Malmberg who seeks a particular bending advantage while retaining strength. (Answer at p. 6).

However, as previously noted there is no teaching in Malmberg to relocate the internal, weakly dimensioned part 3 of Malmberg's shaft 1 to the upper portion of a detachable blade as required by the claims. Moreover, as was the case in Meumann, there is no teaching in Christian to suggest that the hockey stick be weakened in any manner. Consequently, there is no teaching or suggesting in either Malmberg or Christian to relocate the weakly dimensioned part 3 of Malmberg's shaft to Christian's disclosed detachable blade.

Moreover, contrary to the Examiner's Answer, Christian expressly *teaches away* from the combination of Malmberg's weakened part 3 and Christian's disclosed detachable blade. Christian teaches "that the weak point of the replacement blade is the point at which the blade joins with the lower end of the handle." (Christian at Col. 2:2-4) and that the object of the invention disclosed in Christian is to "provide a replacement blade for a hockey stick handle which is reinforced to limit breakage at the point of connection with the handle." (Christian at Col. 2:56-59).

Since Christian is directed to minimizing breakage by reinforcing the construction of the blade, it's teachings are clearly contrary to incorporating a blade configuration that inherently weakens the blade as contended by the Examiner's Answer; because to do so would effectively undermine the notion that the blade requires the reinforcement taught by Christian. Consequently,

Christian not only fails to disclose or otherwise suggest the combination contended or otherwise suggested by the Examiner's Answer, it in fact teaches away from this combination and does so in a manner that is even more express than Meumann in that it expressly not only attempts to solve the acknowledged breakage concern by disclosing a configuration remedy (i.e. a two piece hockey stick) it goes further by disclosing that the blade be strengthened. Consequently, it is respectfully submitted that claims 22 and 30 are allowable over Malmberg in view of Christian, or *vice versa*.

IV. Claims 1, 2 and 17-22 Are Not Obvious - - Malmberg Does Not Teach a Defined Region of Reduced Longitudinal Bending Stiffness Relative to the Bordering Regions Located on Either Side

The Examiner's Answer contends that Claims 1, 2 and 17-21 are obvious over Malmberg in view of Meumann (and *vice versa*) and Claim 22 is obvious over Malmberg in view of Christian (and *vice versa*). (Answer at p. 3). Each of those claims requires a region of reduced longitudinal bending stiffness relative the bordering regions located on either side thereof.

As set forth in Section I above, the Examiner's Answer as to claims 17-21 fails to consider the Malmberg reference in its entirety but rather improperly attempts to sever the weakly dimensioned part 3 from the remaining structures of the hockey stick disclosed in Malmberg. Furthermore, as set forth in Section II and III above, the Examiner's Answer fails not only to recognize that the Malmberg reference teaches away from "a defined region of reduced longitudinal bending stiffness" in the *blade* as required in claims 1, 2 and 17-22; the Malmberg references teaches that the reinforcement device 4 of Malmberg in fact expressly discloses the addition of stiffness to the weakened area 3 of the shaft 1 to eliminate the disadvantage of breakage. (Malmberg at p. 1, ¶ 1 and p. 2 ¶ 7). In addition, the Christian and Meumann references teach away from the claims, in that they expressly disclose a means to overcome breakage in the blade by providing (1) a means to

extend the life of the hockey stick via a connection means as disclosed in Meumann and (2) by reinforcing the blade of the hockey stick as disclosed in Christian. Consequently, the contention set forth in the Examiner's Answer is contrary to the express teachings in the cited references in that it contends or otherwise suggest that "a defined region of reduced longitudinal bending stiffness" set forth in the claimed invention, may be located in the detachable blade when such a contention or suggestion is expressly refuted by the vary references upon which the Examiner's Answer relies. Consequently, it is respectfully submitted that claims 1, 2 and 17-22 are allowable for this additional reason.

CONCLUSION

Applicants respectfully submit that Claims 1, 2 and 17-30 are not rendered obvious by any combination of the Malmberg, Meumann and Christian cited references and request that the outstanding rejections under 35 U.S.C. § 103(a) be withdrawn or otherwise reversed and the application expeditiously proceed to allowance.

Respectfully submitted,

JONES DAY

Dated: April 12, 2004

By: _____



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